

### REMARKS

Claims 1, 2 and 4-18 were pending in this application. According to the February 13, 2001 Office Action, claims 1, 2 and 4-18 were rejected. Accordingly, claims 1, 2 and 4-18 are under consideration.

#### Reissue Declaration

The Examiner maintained that the Reissue Declaration filed the subject application is defective because it fails to describe the actual errors in the patent. The Examiner rejected claims 1, 2 and 4-8 based upon the defective Reissue Declaration.

In response, Applicant submits herewith a new Reissue Declaration that describes the actual errors in the patent as the Examiner requested. Accordingly, the Examiner is kindly requested to withdraw this rejection.

#### Rejection under 35 U.S.C. §103(a)

The Examiner rejected claims 1-6 under 35 U.S.C. §103(a) as allegedly unpatentable over Friedheim, GB 712,828.

In response, Applicant respectfully traverse the Examiner's rejection. The Examiner acknowledges that the molar ratio of approximately 1:1 to approximately 3:1 of the trivalent bismuth salt to the thiol compound is not disclosed by Friedheim. However, the Examiner stated that a person skilled in the art would have sought an optimal ratio of the two ingredients to obtain a therapeutically effective composition. This is simply not obvious from Friedheim which does not teach the anti-bacterial activity of the present invention. Thus, it would not be possible for a person skilled in the art who is not aware of the antibacterial property of the present invention to reasonably seek the most efficacious proportions in order to reach the therapeutic endpoint that the present invention teaches. The above claimed molar ratio was found to be ideal for anti microbial action (see column 2, lines 63-66) and not for the activities associated generally with bismuth compounds which were known at the time Friedheim was published (see bottom of the left side of page 5 of Friedheim, the paragraph before the claims). Applicant notes that using

hindsight based on the teaching of the present application is not appropriate for an obviousness rejection. Thus, even if a person skilled in the art is motivated to find the ideal ratio of the compounds to reach for example a better stability based on Friedheim's teachings, such person is not likely to arrive at the same ratios disclosed in the present invention when these ratios were optimized for maximum anti microbial activity. Accordingly, the cited art does not render the invention as claimed obvious and the Examiner is kindly requested to withdraw this rejection.

In light of the foregoing remarks, it is respectfully submitted that this application is now in condition to be allowed and the early issuance of a Notice of Allowance is respectfully solicited. If there are any issues or amendments the Examiner wishes to discuss, the Examiner is encouraged to contact the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231, on June 13, 2001:

Charles C. Achkar

Name of applicant, assignee or  
Registered Representative



Signature

June 13, 2001

Date of Signature

DAM/CCA:lac

Respectfully submitted,



Charles C. Achkar

Registration No.: 43,311

OSTROLENK, FABER, GERB & SOFFEN, LLP

1180 Avenue of the Americas

New York, New York 10036-8403

Telephone: (212) 382-0700